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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/906,995  | 07/17/2001  | Haruhiko Kinoshita   | NECW 18.854         | 6474             |
| 26304   | 7590        | 09/13/2005           | EXAMINER            |                  |
| KATTEN MUCHIN ROSENMAN LLP<br>575 MADISON AVENUE<br>NEW YORK, NY 10022-2585 |             |                      | GARG, YOGESH C      |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3625                |                  |

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |                     |
|------------------------------|-----------------|---------------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s)        |
|                              | 09/906,995      | KINOSHITA, HARUHIKO |
|                              | Examiner        | Art Unit            |
|                              | Yogesh C. Garg  | 3625                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 July 2005.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3 and 5-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3 and 5-8 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Response to Amendment***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Response to Arguments***

2. Applicant's arguments, see Remarks, pages 4-6, filed 7/27/2005, with respect to the rejection(s) of claim(s) 1-3 and 5-8 under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Gardner in view of Pugliese and further in view of Japanese publication 11-215264 published on August 6, 1999 to Funaoka et al., hereinafter referred to BUERII JAPAN: KK received in the IDS on 5/20/2004 from the applicant, hereinafter referred to BUERII.

This is a non-final office action.

### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardner in view of Pugliese and further in view of Japanese publication 11-215264 published on August 6, 1999 to Funaoka et al., hereinafter referred to BUERII JAPAN: KK received in the IDS on 5/20/2004 from the applicant, hereinafter referred to BUERII.

Gardner teaches a method and system for combining sales and usage transactions into one transaction, and eliminates the issuance of accountable and specific travel authorization. Gardner further teaches:

- Registering in combination corporations and personal mileage identification number in a corporation vs. individual relationship database (pertaining to claims 1, 3, and 5 - 8): a Customer/corporate profile database where traveler preference information including affinity membership numbers and corporate travel policy information is stored (Gardner: paragraph 0080).
- Asking the corporate vs. individual relationship database whether the boarder is an employee of one of the corporations using the personal mileage identification as a retrieval key (pertaining to claims 1 and 7): the profiles booking support system communicates with the corporate customer database through APIs (Gardner: paragraph 0083). The APIs validate the user's logon and ensure s/he is entered in the database (Gardner: paragraph 0084).
- Selecting whether an entity making a reservation is a corporation registered for a corporate mileage service or an individual (pertaining to claim 2): a reservation process that includes accessing last seat availability, seat map assignments, booking "wrap up" [PNR] creation, and frequent traveler data (Gardner: paragraph 56). The process further includes specification of the traveler's desired trip information, selection of flights from viable trip options, determination of flight availability/seat assignment, and etc. Profile information at the customer and the corporate level provides facilitation at each of these stages of the booking process (Gardner: paragraph 0057).
- Comparison between working date and location of the employee and the date of reserving or using the vehicle covered by the mileage service (pertaining to claim 8): a customer/corporate database where "every booking is stored with the traveler's unique

identifier, linking present and historic booking to corporation/employee" (Gardner: paragraph 0082) and allows for corporate travel reporting (Gardner: paragraph 0081).

Gardner fails to disclose:

- Transmitting the personal mileage identification number when a reservation is made using a reservation terminal (pertaining to claims 1 - 2. and 5 - 8):

Pugliese teaches a method ,and system for issuing an electronic authorization and validation of airline reservations using the Internet. Pugliese further teaches making a reservation by accessing the reservation center via an ATM (Pugliese: paragraph 0040) and a reservation number for a particular flight is issued and identified with a passenger name and I.D. card number (Pugliese: paragraph 0041). Therefore, it would have been obvious to one of ordinary skill in the art at the time, of the invention to modify Gardner to include transmitting of personal mileage identification number when a reservation is made as taught by Pugliese, in order to eliminate paper ticketing (Pugliese: paragraph 0023). Transmitting acceptance when a boarding process is carried out using an acceptance terminal (pertaining to claims 1 - 2 and 5 - 8): Pugliese further discloses that at the boarding gate terminal (Pugliese: paragraph 00659) an optical or magnetic reader reads the I.D. number from the boarding pass and an indication of boarding is stored in the passenger's record on the main computer (Pugliese: paragraph 0060). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Gardner to include transmitting of persona mileage identification number when a boarding process is carried out as taught by Pugliese in order to allow an agent of the airline to validate a passenger's right to board without presenting a valid ticket (Pugliese: paragraph 0026).

- Adding boarding miles to the accumulated miles of the boarder (pertaining to claims 1 and 7): Pugliese further teaches a system that automatically updates the frequent flier record (Pugliese: paragraph 0062) that is stored on the central computer and accessed through an ATM (Pugliese: paragraph 0049). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Gardner to include adding the accumulated miles upon boarding as taught by Pugliese in order to provide up-to-the-minute information for the passenger (Pugliese: paragraph 0024).

**The combination of Gardener and Pugliese fails to disclose:**

- Subtracting the miles from the accumulated miles of the boarder and adding the subtracted miles to the miles of the corporation (pertaining to claims 1 and 7): BUERII teaches a computerized bill processing system and method to separate and account for business use and private use. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, BUERII faced the same problem as the applicant of identifying and separating the personal and corporate data referring to telephone billing charges [in the applicant case the data was eamed frequent flier miles] and his invention provided the solution such that a data processing unit was provided to received the bill data [ in the applicant case it will be eamed frequent flier miles data] and this system was configured to identify if this data is to be accounted for the corporation or personally to the employee/individual and if it was determined that data belonged to corporation then it

will be separated out from the rest of the billing information and would be applied to the corporation account [in the applicant's case if it was determined that the earned frequent flier miles belong to the corporation as it was an official trip then those miles would be separated or subtracted and added to the corporate account]. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Gardner and Pugliese to include subtracting the miles from the accumulated miles of the boarder and adding the subtracted miles to the miles of the corporation as taught by BUERII in order to allow for corporate to receive the award because corporate has spent for the trip of the employee/boarder and therefore corporate is justified to receive the benefit and not the employee/boarder.

Note: The teachings of the other two references that is, Japanese Patents 09-034962 to Hitachi received with the IDS on 5/20/2004 and 2000-132609 to Ordertrust LLC received with the IDS on 1/14/2004 are also pertinent to the problem [of separating the data and accounting for the corporate and personal use separately] with which the applicant was concerned.

- Selectively storing earned mileage based on selection, usage details, or a combination of working data and usage details (pertaining to claims 2, 5, 6, and 8Z  
Pugliese discloses an ATM located at the gates that will allow passengers to check their messages, and frequent flier record through the database and the ability to determine the extent of the accumulated miles (Pugliese: paragraph 0065). The passenger also has the option of selecting how frequent flier miles are to be used, such as for phone calls, refreshments, and other services or activities (Pugliese: paragraph 0074). Walker discloses a transaction reward method that assesses rewards points based upon transaction parameters defined within a frequent shopper rules database (Walker: Column 4, lines 3033). The frequent shoppers rules database

is used in context with a transaction to assess the rewards points based on the transaction itself and appropriately credit those rewards points to the proper member's or account holder's account (Walker: Column 8, lines 34-38). It would have been obvious to one skilled in the art to further modify the combination of Gardner and Pugliese to include selectively storing earned mileage as taught by Walker in order to reward multiple shoppers using one account (Walker: Column 2, lines 8-10) and to take the most advantage of the frequent flier miles (Pugliese: paragraph 0075).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg  
Primary Examiner  
Art Unit 3625